

94 Sub 88 15. (Amended) A system according to claim 1, [wherein said calling party can interact] further comprising interaction means for permitting the calling party to interact with said generated announcement at any time by initiating a predetermined response.

Please cancel claims 9, 10 and 16.

REMARKS

Claims 1-8 and 11-15, as amended, are active in this application. Claim 1 had been amended to include the limitations of claims 9 and 10 and to further indicate that the prerecorded announcement is generally continuous. Claims 2 and 3 have been amended to substitute the term "ringback" for "ring". Claims 6 and 7 have been amended to more clearly define the structure by which the calling party participates in selecting an announcement and the inclusion of a video terminal which is associated with the telephone network. Claim 15 has been amended to recite the means which permit interaction between the calling party and the selection of information from or other participation with the system. Claims 9, 10 and 16 have been cancelled. Applicants respectfully submit that no new matter has been added to the application by the foregoing amendment to the claims.

The Examiner has objected to the drawings for misspellings in several of the blocks in the flowcharts of Figs. 3, 4, and 7. Submitted herewith are copies of Figs. 3-6 which indicate the corrections to the misspellings in red ink. Subject

to the approval of the Examiner, the corrections proposed on the attached sheets will be made and formal drawings will be submitted upon receipt of a Notice of Allowability.

The Examiner has objected to the disclosure because of various informalities. The Examiner contends that the use of the term "ring signal" is incorrect and should be replaced by the term "ringback signal". Applicants have accordingly amended the specification and claims to include the term "ringback signal".

The Examiner has also objected to the description of the microprocessor being an IBM compatible personal computer. Applicants have amended the specification to indicate that the microprocessor is preferably of a type which is typically used in an IBM compatible personal computer. Applicants have reviewed the specification and corrected additional informalities which were noted. Applicants respectfully request that the objection to the specification be withdrawn.

The Examiner has rejected claims 6, 7, and 15 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject which Applicants regard as the invention. The Examiner contends that claim 6 lacks proper antecedent and further the Examiner contends it is unclear how the calling party can participate in the selection of the type of announcement. Applicants have amended claim 6 to indicate that the system comprises selecting means for allowing the calling party to select the type of announcement to be played. The calling party can select the announcement by a

number of ways such as by actuating one or more of the keys of a telephone touch pad, keyboard or other form of a response such as voice recognition. For example, the message being played may provide a prompt such as, "please press the # key for more information". At that point in the message sequence, the calling party could press the # key on the telephone touch pad and automatically be connected to a different part of the telephone marketing system to learn more about the particular advertisement. It is foreseen that the calling party could receive a selection of choices and could activate one or more choices by transmitting the appropriate prompt signal.

The Examiner contends that claim 7 is vague as to the connections and intended purpose of the video terminal. Applicants have amended claim 7 to indicate that the network includes a video terminal which is connected to the network and is capable of receiving video messages transmitted through the network. The video terminal is preferably a video telephone or television monitor for receiving full motion video messages directly from the telephone network. Alternatively, the video terminal could be a computer monitor. It is intended that the video terminal be capable of receiving and displaying video advertising which is generated specifically as part of the telephone message.

With respect to claim 15, the Examiner contends that it is unclear when and under what circumstances the caller can interact with an announcement. Applicants have amended claim 15 to indicate that the system includes interaction means for

permitting the calling party to interact with the announcement by initiating a predetermined response. The calling party is able to interact with the marketing system by responding to prompts by either pressing an appropriate telephone touch pad key or by providing other responses such as voice responses. By interacting with the telemarketing system, the calling party can request additional information, select the type of announcement which is to be transmitted or be connected to a third party.

Applicants respectfully submit that claims 6, 7, and 15, as amended, are now sufficiently definite and request that the rejection of these claims under 35 U.S.C. § 112 be withdrawn.

The Examiner has rejected claims 1-5, 12-14 and 15 under 35 U.S.C. § 102(b) as being anticipated by Baral et al. (U.S. Patent No. 4,932,042). The Examiner contends that Baral et al. discloses a system in which the caller is presented with either a ringback or a busy signal and that the system can provide prerecorded announcements either between or superimposed on the call progress signals. The Examiner further contends that the Baral et al. system is applicable in either a local, multi-exchange or toll system. Applicants respectfully traverse the rejection.

The present invention is directed to a marketing system for selectively modifying an existing telephone network by modifying a portion of the call processing software of the existing telephone network and by replacing at least a portion of an audio call progress signal generated by a telephone network by

a generally continuous prerecorded announcement. This modification of the call processing software to incorporate a prerecorded announcement is done independently of the called party. When a calling party places a call to an identified called party at a second location, the network determines the busy/idle status of the telephone of the called party.

Irrespective of the status, the network causes at least one generally continuous announcement to be played to the calling party for a predetermined period of time instead of transmitting to the calling party either a ringback signal or a busy signal. While the system is transmitting the announcement to the calling party, the system independently checks the status of the telephone of the called party to determine if the status of the called party telephone changes. Once the called party answers the telephone, the call is immediately completed and the announcements cease.

Baral et al. is primarily directed to a system for providing voice message services and not for providing announcements such as advertisements to the calling party. The Baral et al. system provides information superimposed between or substituted for ringback or busy signals relative to leaving a message for the called party about the specific called party. To the contrary, the present invention is not in any way related to the identity of the called party nor is it related to completing the call to the called party. The present invention delivers information to the calling party which is established by outside

parties which are not related to or associated with the called party. In addition, the present invention monitors the busy/idle status of the called party phone and connects the calling party to the called party only when the called party answers the phone. In the Baral et al. system, the phone call is immediately diverted to a voice messaging service in the case of the called party phone being busy and makes no additional attempts to determine the busy status of the called party or to thereafter complete the call. The present invention checks the busy/idle status at predetermined intervals while the system is playing announcements to the calling party. If there is a change in the busy/idle status of the called party, the system recognizes the change in status and if the called party then answers the telephone, the calling party is immediately connected to the called party and the announcements stop. In the Baral et al. system, if a busy signal is detected by the system, the system gives the calling party only a single option, leaving a voice mail message or not. The Baral et al. system does not continually check the busy/idle status of the called party's phone and later connect the calling party to the called party if the status of the called party phone changes. As such, Applicants respectfully submit that the Baral et al. reference does not disclose Applicants' invention and respectfully requests that the rejection of claims 1-5, 12-14 and 15 under 35 U.S.C. § 102(b) be withdrawn.

The Examiner has rejected claim 6 under 35 U.S.C. § 103 as being unpatentable over Baral et al. as discussed above in view of either Akiyama (U.S. Patent No. 4,720,848) or Sheinbein (4,227,649). The Examiner contends that both Akiyama and Sheinbein disclose arrangements for callers which provide stored prerecorded announcements and in which the callers can participate in the selection thereof. The Examiner argues that it would be obvious to apply the teachings of Akiyama or Sheinbein to the Baral et al. system since all three references involve automatically providing callers with prerecorded announcements based on the party called. Applicants respectfully traverse the rejection.

As discussed above, Baral et al. is directed to a system for leaving voice messages when a called party is unavailable. Unlike the present invention, the Baral et al. system does not check the busy/idle of the called party at predetermined intervals, nor does Baral et al. provide the option of connecting the called party to the calling party if the called party answers the telephone irrespective of whether the original status signal was a busy or idle signal. Claim 6 has been amended to indicate that the system includes selecting means for allowing the calling party to select a type of announcement to be played. While the Baral et al. system provides selection as to whether or not a calling party wishes to leave a voice message, the Baral et al. system does not allow the calling party to select the type of announcement which is to be played to the

calling party. As such, the Baral et al. system does not teach or disclose Applicants' invention. In fact, Baral et al. teaches away from the invention since to permit a calling party to select a message would not be consistent with leaving a message for the called party.

Both Akiyama and Sheinbein are likewise directed to methods for leaving messages to a called party or for a called party to receive information about a calling party such that the called party can determine the urgency of the phone call and decide whether to accept the call or to direct the call to a voice messaging system. The information transferred to the called party by the system is information left by the calling party, i.e., the caller's name and the reason for calling. In the present invention, the announcements are generated by third parties without regard to the identity of the called party and are played to the calling party. To the contrary, the Akiyama and Sheinbein systems are directed to transferring a specific message to the called party and letting the called party determine whether or not to accept the call. In addition, the information provided to the called party in both the Akiyama and Sheinbein systems can affect the destination of the call. If the called party after hearing the information does not wish to speak to the calling party, the calling party is directed to a voice message system. The present invention is a passive system which provides information only to the calling party (not the called party) and does not itself affect the ultimate outcome of where

the call is directed. With the present invention, the transfer of the call to the called party depends only upon the status of the called party's telephone. Furthermore, while the calling party can participate in the selection of a type of announcement which is to be played, the selection does not have any effect on the ultimate destination of the call. As such, Applicants respectfully submit that neither Sheinbein or Akiyama teach or disclose Applicants' invention.

Applicants further submit that the combinations of either Baral et al. and Akiyama or Baral et al. and Sheinbein do not teach or disclose Applicants' invention. Applicants respectfully submit that neither Baral et al., Akiyama or Sheinbein disclose a system which checks the busy/idle status at predetermined intervals and which, in the case of a change in the busy/idle status, completes the call to the calling party when the called party answers the telephone. Applicants respectfully request that the rejection of claim 6 under 35 U.S.C. § 103 be withdrawn.

The Examiner has rejected claims 7, 8 and 11 under 35 U.S.C. § 103 as being unpatentable over Baral et al. as discussed above in view of Sleeve (U.S. Patent No. 4,811,382). The Examiner has incorrectly assumed that the video terminal as recited in claim 7 is intended to refer to a computer monitor. With respect to the sequencing feature recited in claim 8, the Examiner contends that such a feature is inherent in the Sleeve system. Applicants respectfully traverse the rejection.

Contrary, to the Examiner's assertion with respect to claim 7, the video terminal as recited in claim 7 is intended to relate to providing visual advertisements on a video phone or a similar piece of hardware, such as a combination television/telephone. To the contrary, Sleevei specifically refers to data transmission via a modem and ultimately it is assumed that the modem is connected to a computer which may have a monitor. This is not the intention of the present invention. The present invention is directed to a system for providing visual advertising, i.e., to calling parties having video telephones and/or other video equipment and audio information to calling parties having standard telephone equipment. Applicants respectfully submit that none of the references cited by the Examiner relate to a video terminal which is either a video phone or a combination of a television and telephone.

Sleevei is directed to a system for supplying messages to the calling party during the ringback period of the telephone call. The message are preferably applied between successive tones during the ringback period and are terminated when the called party answers the phone. Contrary to the present invention, the Sleevei reference does not address the situation where a busy signal is detected for the called party. When a busy signal is detected, the Sleevei system treats the call in a conventional manner and does not continually check the status of the called party to determine when the called party's phone is again free. Nor does the Sleevei reference disclose connecting the calling party to the called party if the called party answers

the telephone irrespective of whether a busy signal or an idle signal is initially detected. As such, Applicants respectfully submit that neither Baral et al. or Sleevei, whether taken separately or in combination, teach or disclose Applicants' invention.

It is well settled that when making a rejection under 35 U.S.C. § 103, the Examiner has the burden of establishing a prima facie case of obviousness. The Examiner can satisfy this burden only by showing an objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references in the manner suggested by the Examiner. In re Fine, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). The mere fact that the prior art could be modified in the manner proposed by the Examiner does not make the modification obvious unless the prior art suggests the desirability of the modification. Ex parte Dussaud, 7 U.S.P.Q.2d 1818, 1820 (PTO Bd. App. & Int. 1988).

It is respectfully submitted that in making the present rejection, the Examiner has employed impermissible hindsight in using Applicants' disclosure and claims to conduct a search of the prior art to locate a telecommunication system (Baral et al.) which provides some type of message to the calling party. Once such a telecommunication system was located, the Examiner concluded, without any specific support or objective teachings in Baral et al., that it would have been obvious to one of ordinary


skill in the art to modify the Baral et al. system to include the detection of the busy/idle status of the called party's phone even though neither Baral et al. nor Sleeve teach or even remotely suggest periodically checking the status of the called party phone when the called party phone initially has a busy status.

As the Court of Appeals for the Federal Circuit points out, it is impermissible to use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. In re Fine, supra at 1600. Accordingly, it is respectfully submitted that the rejection of claims 7, 8 and 11 is improper and, therefore, should be withdrawn.

In view of the foregoing amendment, it is respectfully submitted that the present application, including claims 1-8 and 11-15, as amended, is in condition for allowance and such action is respectfully requested.

Respectfully submitted,

MARK R. GREGOREK ET AL.

11/28/93 By: 
(Date)
LESLIE L. KASTEN, JR., ESQ.
Registration No. 28,959
PANITCH SCHWARZE JACOBS & NADEL
1601 Market Street - 36th Floor
Philadelphia, PA 19103
Telephone: (215) 567-2020

LLK/MLS:djw